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10/521,772	01/11/2006	Ilkka Westman	39700-791N01US/NC39771US	1699

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EXAMINER
WONG, BLANCHE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)	
Office Action Summary	10/521,772	WESTMAN ET AL.	
	Examiner	Art Unit	
	Blanche Wong	2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>22 April 2009</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-31,42,43 and 62-65</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-31,42,43 and 62-65</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

1.   Applicant's arguments filed April 22, 2009 have been fully considered but they are not persuasive.

2.   With regard to claims 1-31, 42-43, and 62-65, Applicants states that "RFC fails to disclose or suggest 'receiving a message at an interrogating call session control function using a public service identity' …. Additionally, RFC fails to disclose or suggest 'originating a message from a network function using a public service entity'". Remark, p.14, lines 18 – p.15, line 2. However, Examiner respectfully disagrees. Applicants explain that "In RFC, an application-layer control (signaling) protocol is presented for creating, modifying, and terminating sessions with one or more participates." Remark, p.14, lines 12-14. The one or more participates are in a public service identity, that is, in an Internet environment. Internet is a public service identity. Applicants further explain that "'his' SIP identity" is a private user identity and thus, "RFC discloses a communication establishment process that relies on private user identities that identify a private user, which is not a public service …." Remark, p.15, lines 9-11. The "his" SIP identity is public information used to establish SIP communication over the Internet. Again, Internet is a public service identity. Therefore, the reference RFC meets the limitation "using a public service identity".

3.   Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

4.   According to Applicants' reasoning, Applicants states that "the public service

identities used by the claimed invention can identify services that are hosted by

application servers capable of executing service specific logic corresponding to the

public service identity. ... Further, the use of public service identities ... can enable a

request to always be routed via a CSCF, an S-CSCF, a destination network, and/or

according to operator decision, as opposed to being routed to a user according to a

private user identity .... RFC does not describe the private user identities as enabling

any of these functions or capabilities." Remark, p.15, lines 12-19. However, Examiner

respectfully disagrees. "Any of these functions or capabilities" are unfound in the

claims. Claim language merely recites "a network function". SIP is a network function.

Therefore, according to Examiner's reasoning, the reference RFC meets the limitation

"a network function using a public service entity'".

5.   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., services that are hosted by application servers capable of executing service

specific logic, a CSCF, an S-CSCF, etc.) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 101

6.   Claims 1,12,22,24,28,42 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S. C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not quality as a statutory process.

DETAILED ACTION

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8.   **Claims 1-31,42,43,62-65** are rejected under 35 U.S.C. 102(a) as being anticipated by RFC3261 titled "SIP: Session Initiation Protocol".

With regard to claims 1 and 65, RFC3261 discloses

receiving a message **(INVITE) ("INVITE is an example of a SIP method that specifies the action that the requestor wants the server to take. The INVITE request contains a number of header fields … provide additional information about a message", p.10, para. 4)** (*See Also* **"SIP message contains a description of the session", p.12, para. 11)** at an interrogating call session control function **(request) ("Each transaction consists of a request that invokes a particular method, or function, on the server", p. 10, para. 4)** using a public service identity **(SIP identity/SIP URI) ("Alice 'calls' Bob using his SIP identity", p.10, para. 3) ("the transaction begins with Alice's softphone sending an INVITE request addressed to Bob's SIP URI", p.10, para. 4)**;

obtaining address information **(DNS)** for a network function **(SIP) ("DNS lookup to find the SIP server that serves the Biloxi.com domain", p.13, para. 3)** for which said message is intended; and

sending said message to said network function in accordance with said address information **("Bob's SIP phone receives the INVITE", p.13, para. 4)**.

With regard to claim 2, RFC3261 discloses said message is sent directly to the network function via a proxy or gateway element **(proxy server, p.13, para. 3) (***See Also* **atlanta.com proxy on p.11)**.

With regard to claim 3, RFC3261 discloses querying a database **(database of atlanta.com proxy) ("The proxy server consults a database, generically called a location service", p.13, para.3)**.

With regard to claim 4, RFC3261 discloses a subscription location function **(DNS lookup/location service) ("The atlanta.com proxy server … performing … DNS lookup to find the SIP server that serves the Biloxi.com domain", p.13, para. 3)** (*See Also* **"The proxy server consults a database, generically called a location service", p.13, para.3)**.

With regard to claim 5, RFC3261 discloses said database provides said address information for said network function **(database) ("The proxy server consults a database, generically called a location service", p.13, para.3)**.

With regard to claim 6, RFC3261 discloses said database provides information identifying a further database **(database of biloxi.com proxy) ("The proxy server consults a database, generically called a location service", p.13, para.3)**.

With regard to claim 7, RFC3261 discloses said further database comprises a user mobility service **(location service) ("The proxy server consults a database, generically called a location service", p.13, para.3)**.

With regard to claim 8, RFC3261 discloses said further database contains said address information **(location)** (**"The proxy server consults a database, generically called a location service", p.13, para.3**).

With regard to claim 9, RFC3261 discloses said further database contains configuration information (**"The Biloxi.com proxy server adds another Via header field value with its own address to the INVITE and proxies it to Bob's SIP phone", p.13, para. 3**) of said network function (**SIP**).

With regard to claim 10, RFC3261 discloses whether said message is for an IP internet protocol multimedia core network subsystem target (**Fig. 1: SIP session on p.11**).

With regard to claim 11, RFC3261 discloses said receiving, obtaining, and sending are followed when determination is made that said message is for a IP internet protocol multimedia core network subsystem target (**"Alice might have typed in Bob's URI or perhaps clicked on a hyperlink or an entry in an address book", p.10, para. 3**).

With regard to claim 43, RFC3261 discloses said network function comprises a server (**atlanta.com proxy and biloxi.com proxy in Fig. 1 on p. 11**), said server being configured to send a message for at least one user via a serving call session control

function **(INVITE request from Alice)** and to send a message for a least one user via

an interrogating call session control function **(INVITE request from atlanta.com proxy)**

("the transaction begins with Alice's softphone sending an INVITE request

addressed to Bob's SIP URI", p.10, para. 4).

      With regard to claim 12, RFC3261 discloses

      originating a message **(INVITE)** from a network function **(SIP method) ("INVITE**

is an example of a SIP method that specifies the action that the requestor wants

the server to take. The INVITE request contains a number of header fields ...

provide additional information about a message", p.10, para. 4) (*See Also* **"SIP**

message contains a description of the session", p.12, para. 11) using a public

service entity **(SIP identity/SIP URI) ("Alice 'calls' Bob using his SIP identity", p.10,**

para. 3) ("the transaction begins with Alice's softphone sending an INVITE

request addressed to Bob's SIP URI", p.10, para. 4);

      determining an address of a proxy entity **(SIP server that serves the Biloxi.com**

domain) to which said message is to be sent **("The atlanta.com proxy server ...**

performing ... DNS lookup to find the SIP server that serves the Biloxi.com

domain", p.13, para. 3); and

      routing said message to said proxy entity **("The biloxi.com proxy server**

receives the INVITE ...", p.13, para. 3),

wherein said message is routed from said proxy entity (**atlanta.com proxy**) to an entry point (**biloxi.com proxy**) of a target network (**"biloxi.com is the domain of Bob's SIP service provider", p.10, para. 3**).

With regard to claim 13, RFC3261 discloses said entry point is in a same network (**Atlanta.com**) as said network function (**SIP method**).

With regard to claim 14, RFC3261 discloses said entry point is in a different network (**Biloxi.com**) than said network function (**SIP method**).

With regard to claim 15, RFC3261 discloses originating one of a session and a transaction (**SIP/transaction**) (**"SIP is based on an HTTP-like request/response transaction model", p.10, para. 3**).

With regard to claim 16, RFC3261 discloses querying a database (**database**) (**"The proxy server consults a database, generically called a location service", p.13, para.3**).

With regard to claim 17, RFC3261 discloses determining the proxy entity (**Biloxi.com proxy server**) from information contained in said function (**SIP method**) (**"As a result, it obtains the IP address of the Biloxi.com proxy server", p.13, para. 3**).

With regard to claim 18, RFC3261 discloses determine the entry point
(Biloxi.com proxy server) to which said message is to be routed **("As a result, it
obtains the IP address of the Biloxi.com proxy server", p.13, para. 3)**.

With regard to claim 19, RFC3261 discloses said proxy entity **(Atlanta.com
proxy)** is configured to determine a target entry point **(Biloxi.com proxy server)** to
which said message is to be sent **("As a result, [Atlanta.com proxy server] obtains
the IP address of the Biloxi.com proxy server", p.13, para. 3)**.

With regard to claim 20, RFC3261 discloses said proxy entity **(Atlanta.com
proxy)** is configured to determine a target entry point (**Biloxi.com proxy server)** to
which said message is to be sent **("As a result, [Atlanta.com proxy server] obtains
the IP address of the Biloxi.com proxy server", p.13, para. 3)** by accessing a
database **(database)** **("The proxy server consults a database, generically called a
location service", p.13, para.3)**.

With regard to claim 21, RFC3261 discloses domain name server **(DNS) ("The
atlanta.com proxy server … performing … DNS lookup to find the SIP server that
serves the Biloxi.com domain", p.13, para. 3)**.

With regard to claim 22, RFC3261 discloses

originating a message **(INVITE)** from a network function **(SIP method)** (**"INVITE
is an example of a SIP method that specifies the action that the requestor wants
the server to take. The INVITE request contains a number of header fields …
provide additional information about a message", p.10, para. 4)** (*See Also* **"SIP
message contains a description of the session", p.12, para. 11)** using a public
service entity **(SIP identity/SIP URI)** (**"Alice 'calls' Bob using his SIP identity", p.10,
para. 3)** (**"the transaction begins with Alice's softphone sending an INVITE
request addressed to Bob's SIP URI", p.10, para. 4)**;

determining an interrogating call session control function **(request)** to which said
message is to be sent **("Each transaction consists of a request that invokes a
particular method, or function, on the server", p. 10, para. 4)**;

routing **(request from Alice to atlantic.com proxy server, and request from
atlantic.com proxy server to biloxi.com proxy server)** said message directly to said
interrogating call session control function **(request)** when said interrogating call session
control function **(request)** is in a same network **(both requests in atlantic.com)** as
said network function **(SIP method)**.

With regard to claim 23, RFC3261 discloses

originating a message **(INVITE)** from a network function **(SIP method)** (**"INVITE
is an example of a SIP method that specifies the action that the requestor wants
the server to take. The INVITE request contains a number of header fields …
provide additional information about a message", p.10, para. 4)** (*See Also* **"SIP

message contains a description of the session", p.12, para. 11) using a public

service entity **(SIP identity/SIP URI) ("Alice 'calls' Bob using his SIP identity", p.10,**

para. 3) ("the transaction begins with Alice's softphone sending an INVITE

request addressed to Bob's SIP URI", p.10, para. 4);

      determining an interrogating call session control function **(request)** to which said

message is to be sent **("Each transaction consists of a request that invokes a**

particular method, or function, on the server", p. 10, para. 4);

      routing **(request from Alice to atlantic.com proxy server, and request from**

atlantic.com proxy server to biloxi.com proxy server) (*See Also* **"Each transaction**

consists of a request that invokes a particular method, or function, on the

server", p. 10, para. 4) said message directly to said interrogating call session control

function **(request)** when said interrogating call session control function **(request)** is in a

trusted network **("SIP provides a suite of security services ...", p.9, para. 4)**.

      With regard to claim 24, RFC3261 discloses

      receiving a request **(INVITE request)** from a network function **(SIP method)** at

an interrogating call session control function **(the request from Alice to atlantic.com**

proxy server) ("INVITE is an example of a SIP method that specifies the action

that the requestor wants the server to take. The INVITE request contains a

number of header fields … provide additional information about a message",

p.10, para. 4) (*See Also* **"SIP message contains a description of the session",**

p.12, para. 11) using a public service entity **(SIP identity/SIP URI) ("Alice 'calls' Bob**

using his SIP identity", p.10, para. 3) ("the transaction begins with Alice's

softphone sending an INVITE request addressed to Bob's SIP URI", p.10, para. 4);

determining, at the interrogating call session control function **(request)**, a serving

call session control function **(request)** to which a message from said network function is

to be sent **(INVITE request)** (*See Also* "Each transaction consists of a request that

invokes a particular method, or function, on the server", p. 10, para. 4); and

sending said message to the determined serving call session control function

("Bob's SIP phone receives the INVITE", p.13, para. 4).

With regard to claim 25, RFC3261 discloses a presence **(location)** list server **(a**

DNS server) ("The atlanta.com proxy server ... performing ... DNS lookup to find

the SIP server that serves the Biloxi.com domain", p.13, para. 3) (*See Also* "The

proxy server consults a database, generically called a location service", p.13,

para.3).

With regard to claim 26, RFC3261 discloses querying a database **(database)**

("The proxy server consults a database, generically called a location service",

p.13, para.3).

With regard to claim 27, RFC3261 discloses querying a home subscriber server

(a proxy server is registered in a DNS server or not) ("The atlanta.com proxy

server ... performing ... DNS lookup to find the SIP server that serves the

Biloxi.com domain", p.13, para. 3) ("The proxy server consults a database,
generically called a location service", p.13, para.3).

With regard to claim 28, RFC3261 discloses

receiving a request **(INVITE request)** from a first network function **(SIP method)**
at an interrogating call session control function **(the request from Alice to
atlantic.com proxy server)** ("INVITE is an example of a SIP method that specifies
the action that the requestor wants the server to take. The INVITE request
contains a number of header fields … provide additional information about a
message", p.10, para. 4) (*See Also* "SIP message contains a description of the
session", p.12, para. 11) using a public service entity **(SIP identity/SIP URI)** ("Alice
'calls' Bob using his SIP identity", p.10, para. 3) ("the transaction begins with
Alice's softphone sending an INVITE request addressed to Bob's SIP URI", p.10,
para. 4)**;**

determining, at the interrogating call session control function **(the request from
Alice to atlantic.com proxy server)**, a second network function **(the request from
atlantic.com proxy server to biloxi.com proxy server)** to which a message from said
first network function **(SIP method)** is to be sent **(INVITE request)** (*See Also* "Each
transaction consists of a request that invokes a particular method, or function, on
the server", p. 10, para. 4)**;** and

sending said message to the interrogating call session control function **(the request from Alice to atlantic.com proxy server)** to said second network function **(the request from atlantic.com proxy server to biloxi.com proxy server)**.

With regard to claim 29, RFC3261 discloses a network entity **(SIP identity/SIP URI)** **("Alice 'calls' Bob using his SIP identity", p.10, para. 3)** **("the transaction begins with Alice's softphone sending an INVITE request addressed to Bob's SIP URI", p.10, para. 4)**.

With regard to claim 30, RFC3261 discloses a gateway **(atlantic.com proxy server)**.

With regard to claim 31, RFC3261 discloses an adaptation functionality **("The Biloxi.com proxy server adds another Via header field value with its own address to the INVITE and proxies it to Bob's SIP phone", p.13, para. 3)**.

With regard to claim 42, RFC3261 discloses

receiving a message **(INVITE)** **("INVITE is an example of a SIP method that specifies the action that the requestor wants the server to take. The INVITE request contains a number of header fields ... provide additional information about a message", p.10, para. 4)** *(See Also* **"SIP message contains a description of the session", p.12, para. 11)** at an interrogating call session control function

(request) ("**Each transaction consists of a request that invokes a particular method, or function, on the server**", **p. 10, para. 4**) from a network function (**SIP method**) using a public service identity (**SIP identity/SIP URI**) ("**Alice 'calls' Bob using his SIP identity**", **p.10, para. 3**) ("**the transaction begins with Alice's softphone sending an INVITE request addressed to Bob's SIP URI**", **p.10, para. 4**);

obtaining address information (**DNS**) ("**DNS lookup to find the SIP server that serves the Biloxi.com domain**", **p.13, para. 3**) at said interrogating call session function (**request**) ("**Each transaction consists of a request that invokes a particular method, or function, on the server**", **p. 10, para. 4**) for which said message is intended; and

sending said message from said interrogating call session control function (**request**) ("**Each transaction consists of a request that invokes a particular method, or function, on the server**", **p. 10, para. 4**) in accordance with said address information (**"Bob's SIP phone receives the INVITE", p.13, para. 4**).

With regard to claim 62, RFC3261 discloses

means for receiving a message (**INVITE**) ("**INVITE is an example of a SIP method that specifies the action that the requestor wants the server to take. The INVITE request contains a number of header fields … provide additional information about a message**", **p.10, para. 4**) (*See Also* "**SIP message contains a description of the session**", **p.12, para. 11**) using a public service identity (**SIP identity/SIP URI**) ("**Alice 'calls' Bob using his SIP identity**", **p. 10, para. 3**) ("**the**

transaction begins with Alice's softphone sending an INVITE request addressed

to Bob's SIP URI", p.10, para. 4);

means for obtaining address information **(DNS)** for a network function **(SIP)**

("DNS lookup to find the SIP server that serves the Biloxi.com domain", p.13,

para. 3) for which said message is intended; and

means for sending said message to said network function in accordance with

said address information **("Bob's SIP phone receives the INVITE", p.13, para. 4)**.

With regard to claim 63, RFC3261 discloses

a receiver **(atlantic.com proxy server)** configured to receive a message

(INVITE) **("INVITE is an example of a SIP method that specifies the action that the**

requestor wants the server to take. The INVITE request contains a number of

header fields … provide additional information about a message", p.10, para. 4)

(*See Also* "SIP message contains a description of the session", p.12, para. 11) at

an interrogating call session control function **(request) ("Each transaction consists of**

a request that invokes a particular method, or function, on the server", p. 10,

para. 4) from a network function **(SIP method)** using a public service identity **(SIP**

identity/SIP URI) ("Alice 'calls' Bob using his SIP identity", p.10, para. 3) ("the

transaction begins with Alice's softphone sending an INVITE request addressed

to Bob's SIP URI", p.10, para. 4);

an address information entity **(a DNS server)** configured to obtain address

information **(DNS) ("DNS lookup to find the SIP server that serves the Biloxi.com**

domain", p.13, para. 3) for which said message is intended; and

a transmitter **(Biloxi.com proxy server)** configured to transmit said message to

said network function **(SIP method)** in accordance with said address information

("Bob's SIP phone receives the INVITE", p.13, para. 4).

With regard to claim 64, RFC3261 discloses querying a database **(database)**

("The proxy server consults a database, generically called a location service",

p.13, para.3).

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Blanche Wong whose telephone number is 571-272-
3177. The examiner can normally be reached on Monday through Friday, 830am to
530pm.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Edan Orgad can be reached on 571-272-7884. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.
        Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blanche Wong/
Examiner, Art Unit 2419
July 20, 2009